

**STATEMENT UNDER 37 CFR 3.73(b)**Applicant/Patent Owner: Stanton R. CanterApplication No./Patent No.: 10/587,497Filed/Issue Date: 07-20-2007

Titled:

ANCHORING ELEMENT FOR USE IN BONEStanton R. Canter, a individual

(Name of Assignee)

(Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. ☒ the assignee of the entire right, title, and interest in;
2. ☐ an assignee of less than the entire right, title, and interest in  
(The extent (by percentage) of its ownership interest is \_\_\_\_\_ %); or
3. ☐ the assignee of an undivided interest in the entirety of (a complete assignment from one of the joint inventors was made)

the patent application/patent identified above, by virtue of either:

- A. ☐ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy therefore is attached.

OR

- B. ☒ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as follows:

1. From: Stanton R. CantorTo: Nobel Biocare Services AG

The document was recorded in the United States Patent and Trademark Office at

Reel 019587, Frame 0235, or for which a copy thereof is attached.2. From: Nobel Biocare Services AGTo: Stanton R. Canter

The document was recorded in the United States Patent and Trademark Office at

Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

3. From: \_\_\_\_\_

To: \_\_\_\_\_

The document was recorded in the United States Patent and Trademark Office at

Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet(s).

- ☒ As required by 37 CFR 3.73(b)(1)(i), the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11.

[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, to record the assignment in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

Signature

Date

Printed or Typed Name

Title



**AGREEMENT TO TERMINATE PATENT ASSIGNMENT**

**BETWEEN**

**STANTON R. CANTER**

**AND**

**NOBEL BIO CARE SERVICES AG**

## AGREEMENT TO TERMINATE PATENT ASSIGNMENT

THIS AGREEMENT is made and entered into as of the latest day set out below

by and between

**Stanton R. Canter, D.D.S.**, 5304 Topanga Canyon Blvd. Woodland Hills, CA 91364, USA (the "Seller")

and

**Nobel Biocare Services AG**, Postfach, 8058 Zürich-Flughafen, Switzerland (the "Nobel Biocare")

WITNESSETH:

WHEREAS, Seller is the inventor of an invention concerning dental implants, that is the subject matter of the patent applications set out below;

WHEREAS, Seller and Nobel Biocare entered into a "Patent Assignment Agreement" on or about March 31, 2005, according to which Nobel Biocare purchased from the Seller, the invention, the patent application, certain know-how pertaining to the invention and the patent application and any and all rights deriving therefrom;

WHEREAS, Nobel Biocare has ongoing duties to Seller under the "Patent Assignment Agreement";

WHEREAS, Nobel Biocare has determined that it no longer wishes to pursue commercial exercise of the invention;

WHEREAS, Nobel Biocare wishes to be excused from further duties to Seller under the "Patent Assignment Agreement";

WHEREAS, subject to the terms and conditions of this agreement, Seller wishes to receive from Nobel Biocare the invention, the patent application, and any and all rights deriving therefrom including issued patents in exchange for excusing Nobel Biocare from further duties to Seller under the "Patent Assignment Agreement";

NOW, THEREFORE, the parties agree as follows:

### 1. DEFINITIONS

1.1 Wherever used in this Agreement the following terms shall have the meaning described below:

“**Affiliate**” means an entity that, directly or indirectly, through one or more intermediaries, controls, is controlled by or is under common control with Nobel Biocare.

“**Agreement**” shall mean this Patent Assignment Agreement including all Schedules hereto.

“**Confidential Information**” shall include all information, data and know-how disclosed by each party to the other during the term of the "Patent Assignment Agreement", whether orally or as embodied in tangible materials (including without limitation software, hardware, drawings, graphs,

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charts, disks, tapes, prototypes and samples) which are clearly marked, labeled as "CONFIDENTIAL" or with a similar legend. Even if not bearing a label or confirmed in writing as provided above, all information relating to dental implants provided with a reasonable expectation of confidentiality shall be deemed to be Confidential Information. Regardless of the foregoing, information received by a recipient shall not be deemed to be Confidential Information if the information (a) was already known to the receiving party or was publicly available at the time of disclosure; (b) is disclosed to the receiving party by a third party who is not in breach of an obligation of confidentiality; (c) became or becomes publicly available after disclosure through no fault of the receiving party.

**"Contract"** shall mean this Patent Assignment Agreement excluding all Schedules hereto.

**"Improvement"** shall mean any modification or development of the Invention.

**"Invention"** shall mean an anchoring element for use in bone developed by the Seller as further described in the Patent Applications.

The **"Patent Applications"** shall mean the patent applications described in Schedule 1-Schedule 3 hereto.

**"Patents"** shall mean the entire right, title and interest relating to the corresponding patent applications, national or international, that may follow and/or are derived from the Patent Applications including divisions, renewals and continuations thereof.

**"Proprietary Rights"** under this Agreement include all intellectual property rights related to the Invention, the Patent Applications and Patents, including but not limited to inventions, patent applications, patents, know-how, design, trademarks, trade secrets, copyrights, moral rights, including also any right to secure any of the foregoing rights worldwide and also including any information and disclosures whether or not protectable under law that are developed by the Seller in connection with the Invention and/or the Patent Applications, but not including any intellectual property rights in inventions which are the subject of unrelated patent applications.

The **"Seller's know-how"** shall mean knowledge, experience, data, technology, designs, techniques, drawings, software, and other information and knowledge, relating to the Invention and/or the Patent Applications owned or controlled by the Seller at the time of execution of this Agreement and which the Seller is entitled to disclose and sell to Nobel Biocare.

## **2. SCHEDULES**

2.1 The following Schedules form an integral part of the Agreement:

**Schedule 1** U.S. Patent provisional application no. 60/539,633 filed 28 January 2004

**Schedule 2** U.S. Patent application no. 11/035,266 filed 12 January 2005

**Schedule 3** PCT Patent application no. US 2005/002 717 filed 28 January 2005

2.2 In case of a conflict between the Contract and the Schedules, the Contract shall prevail.

## **3. ASSIGNMENT BACK TO SELLER**

3.1 Subject to the terms and conditions of this Agreement Nobel Biocare hereby agrees to assign

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back to the Seller the Proprietary Rights and entire right, title and interest relating to the Invention, the Patent Applications and the Patents. For the avoidance of doubt, after the execution of this Agreement, Nobel Biocare shall have no further obligation to obtain patent protection for the Invention. For the avoidance of doubt, after the execution of this Agreement, the Seller is entitled, at its own discretion, to any dispositions of the Invention, the Patent Applications and the Patents, such as to license or assign the patent to third parties, including direct competitors of Nobel Biocare.

- 3.2 Nobel Biocare undertakes to execute any necessary additional assignment documents and to do all necessary acts in order to fully and validly transfer to the Seller all the Proprietary Rights. Nobel Biocare undertakes not to use the Invention anywhere in the world after execution of this Agreement and not to assign, transfer, or sell anything that embodies the Proprietary Rights to a third party.
- 3.3 Nobel Biocare shall have no further duty to maintain the Patent Applications and all patents issued pursuant to the Patent Applications from the effective date of assignment to the Seller. Further Nobel Biocare shall pay all license, recording, registration, renewal and other similar fees in connection with maintaining the Patent Applications. If Nobel Biocare, during the period set out in 4.1, for any reason should not fulfill its obligation to maintain the Patent Applications or the said patents in force the Seller may on behalf and at the expense of Nobel Biocare make all arrangements necessary to keep the Patent Applications and the said patents in force and in good standing; for the avoidance of doubt, Seller's right according to this last item shall not apply after the said period.
- 3.4 Nobel Biocare shall pay all licence, recording, registration, and other similar fees in connection with assign back to the Seller the Patent Applications and Patents.

#### **4. COMMERCIAL EXERCISE OF THE INVENTION**

- 4.1 Nobel Biocare shall have no further obligation to commercially exercise the Invention after the date of execution of this Agreement.

#### **5. WARRANTIES**

- 5.1 Nobel Biocare hereby warrants the following on the date of execution of this Agreement:
- (i) the Invention transferred hereunder is fully owned by Nobel Biocare, without being subject to any liens or encumbrances;
  - (ii) Nobel Biocare has not been, and/or is not, in breach of any license or other agreement relating to the Invention;
  - (iii) Nobel Biocare has not, except to the Seller, granted, or is obliged to grant, any license or assignment in respect of the Invention owned or used by the Seller, or is obliged to disclose any know-how related to the Invention to any third party.
- 5.3 To the best of the Nobel Biocare's knowledge:
- (i) there has been no acts of infringement by any third party of any Invention;
  - (ii) the Invention does not infringe upon any intellectual property rights of any third party, although it is expressly acknowledged by Nobel Biocare that Nobel Biocare has made no particular searches or investigations to determinate whether such infringement occurs;

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- (iii) no claim has been filed against the Nobel Biocare, whether for infringement, damages or otherwise, made by any third party, which relates to the use by Nobel Biocare of the Invention;
- (iv) the Invention is not subject matter of any other patent application.

5.4 Nobel Biocare hereby warrants the following on the date of execution of this Agreement:

- (i) Nobel Biocare shall continue to indemnify and defend Seller for any and all disputes, controversies, claims, law suits or other legal matters brought by third parties arising from any event involving the subject matter of this Agreement in which Nobel Biocare was a participant, and shall bear all costs for such legal matters. For the avoidance of doubt, Nobel Biocare shall at its own discretion, without any control of the Seller, have the full and unlimited right to handle any and all issues related to such legal matters;
- (ii) Nobel Biocare shall not indemnify and defend the Seller, if the legal matter in question is caused by the Seller without any participation by Nobel Biocare.

## **6. PRICE, ROYALTY AND PAYMENT**

6.1 Nobel Biocare shall from the day of this Agreement have no further obligation to make any payment to the Seller under Section 6 of the "Patent Assignment Agreement".

## **7. NON-DISCLOSURE OF PROPRIETARY INFORMATION**

7.1 For a period of seven (7) years following the execution of this Agreement each party shall maintain the confidentiality and prevent accidental or other loss of any Confidential Information of the other party with at least the same degree of care as it uses to protect its own Confidential Information but in no event with less than reasonable care. Each party shall immediately notify the other party in the event of any loss or unauthorized disclosure of the Confidential Information of the other party.

7.2 Within sixty (60) days of the execution of this Agreement each party shall return all tangible materials representing the other's Confidential Information other than documents. Upon the execution of this Agreement each party shall promptly destroy all documents representing the other's Confidential Information and all copies thereof and confirm such destruction to the other party in writing within sixty (60) days of the execution of this Agreement. If any documents or other tangible materials representing the other's Confidential Information or copies thereof are later discovered, those materials shall be promptly returned to the other party and the circumstances of their late discovery shall be provided in writing.

7.3 Beginning one (1) year after the execution of this Agreement Seller shall have the right to participate in the development and commercialization of the Invention with any licensee or assignee of the Patent Applications and/or the Patents. Seller's use of mental impressions, regardless of source, during such development and commercialization activities shall not be an unauthorized disclosure of the Confidential Information of the other party.

7.4 Nothing contained in this Agreement or the "Patent Assignment Agreement" shall be construed as granting any property rights, by license or otherwise, to any Confidential Information of the other party, or to any invention or any patent right that has issued or that may issue, based on such Confidential Information.

7.5 This Agreement is not part of the Confidential Information of either party.

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## 8. FORCE MAJEURE

- 8.1 If a party is prevented from fulfilling his obligations under this Agreement by circumstances beyond the party's control such as labour dispute, conflagration, power cut, interruption of or delay to the data communication network (including but not limited to the Internet or telephone connection) or amended official regulation or official intervention, this shall constitute grounds for exemption implying postponement of the date for the performance and exemption from damages and any other sanctions. If the fulfilment of this agreement is delayed in material respects for more than one (1) month on account of a particular stated circumstance, the other party has the right to give notice in writing terminating this agreement.

## 9. ANNOUNCEMENTS

- 9.1 Any announcement concerning this agreement or any matter ancillary thereto shall be made only after prior consent of the other party, provided that nothing herein shall prevent either party from making, in consultation with the other party, any announcement or filing required by law, regulations or by the rules and regulations of any stock exchange on which it is listed or by which it is bound.

## 10. ENTIRE AGREEMENT

- 10.1 Each of the parties to this agreement confirms that this agreement represents the entire understanding and constitutes the whole agreement between the parties in relation to its subject matter and supersedes all prior agreements, covenants, arrangements, communications, representations or warranties, whether oral or written, by any officer, agent, employee or representative of either of the parties.


## 11. GOVERNING LAW AND ARBITRATION

- 11.1 This agreement shall be construed in accordance with and governed by the substantive laws of Switzerland.
- 11.2 Any dispute, controversy or claim arising out of or in connection with this agreement or the breach, termination or invalidity thereof shall be finally settled by the competent court of Zürich, Switzerland. The language to be used in the arbitral proceedings shall be English.

IN WITNESS WHEREOF, the parties hereto have executed two (2) identical copies of this Agreement to be effective as of the latest day and year written below.

Place and date

STANTON R. CANTER



Signature


5-24-2010

Place and date

NOBEL BIOCARE SERVICES AG



Hans Schmotzer, EVP Research and Development

  
Jörg von Manger-Koenig, Group General Counsel